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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/480,344	01/10/2000	KEVIN MICHAEL RUPPELT	9D-EC-19337	4210

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EXAMINER

SMITH, JEFFREY A

ART UNIT PAPER NUMBER

3625

DATE MAILED: 08/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/480,344	RUPPELT ET AL.	
	Examiner	Art Unit	
	Jeffrey A. Smith	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-14,16-26 and 28-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-14,16-26 and 28-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 January 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Response to Amendment

The response filed May 5, 2005 has been entered and considered.

Response to Amendment

Claims 1, 3-14, 16-26, and 28-45 are pending.

Claims 1, 3, 14, 16, 19, and 25 have been currently amended.

Claims 2, 15, and 27 have been cancelled.

An action on the merits follows.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 3-13, 19-24, 30-33, and 38-41 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

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Regarding claims 1, 3-13, and 30-33

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature",

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"natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it

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"enhances" the operation of a machine. *In re Toma* at 857.

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank &*

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Trust Co. at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, *State Street* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

In the present application, these claims fail to recite any specific and non-trivial application of technology in the bodies of these claims. The recitation of certain "technology" such as a product database, buttons, hyperlinks, etc... is noted. However, there is no specific and non-trivial application of such technology.

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Regarding claims 19-24, and 38-41

These claims recite an Internet web page which amounts to either a recitation of an electronic version of "printed matter" (non-functionally descriptive material with or without a supporting substrate or medium) and/or a software or a program, per se, absent its recitation in combination with any computer-readable medium. In either case, the subject matter of these claims fails to define statutory subject matter under 35 USC 101. See MPEP 2106.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 3-9, 11-14, 16-22, 24-26, and 28-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rofrano (U.S. Patent No. 6,035,283) in view of Sammon, Jr. et al. (U.S. Patent No. 6,012,051).

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Rofrano discloses a method, tool, and program product for product selection assistance (col. 1, lines 6-14) comprising, *inter alia*, receiving a product category selection (col. 4, lines 34-38); matching the selection against a product database (abstract); displaying a product matrix (col. 3, lines 55-62; and Table 1); presenting a configuration question (col. 4, lines col. 39-42); receiving a configuration answer (col. 4, lines 34-38); and responsively updating the product matrix comprising removing the selected product configuration parameter from the matrix (note box "207" in Fig. 2; and col. 3, lines 55-62). Product color is disclosed (col. 3, lines 55-57). The database described by Rofrano is interpreted as comprising a hard disk storage medium. Model identifiers are considered to be disclosed under the category "ProductName" in Table 1. Such model identifiers are considered to be Rofrano's generic representations of brand name.

Rofrano does not disclose displacing the selected product configuration parameter to a visible location outside the product matrix.

Sammon, Jr., however, in a similar product selection method, tool, and program product (col. 1, lines 6-12) teaches maintaining selected product configuration parameters along a

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side of a navigation window (col. 12, lines 19-43; and Fig. 4: "200"- "203").

It would have been obvious to one of ordinary skill in the art to have provided the invention of Rofrano to have included displacing the selected product configuration parameter to a visible location outside the product matrix in order to have assisted the user regarding the user's position in a sequence of questions/answers as well as the user's progress in narrowing the product choices (Sammon, Jr.: col. 12, lines 44-48).

Regarding claim 11

See Rofrano at col. 4, line 29-col. 4, line 42.

Regarding claims 13, and 18

See Rofrano (first Q/A) at col. 4, lines 53-54.

Regarding claims 3, 16, and 28

The combination of Rofrano and Sammon, Jr. et al. does not teach inserting an additional product configuration parameter in the product matrix to replace the selected product configuration.

However, it is noted that Rofrano teaches a question script (col. 4, lines 42-65) which amounts to a succession of questions

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that are presented once an answer to a previous question is answered. Rofrano also teaches that each answer has the ability to link other lines of questioning--thereby creating the "Question and Answer Tree" (col. 3, lines 46-52).

It would have been obvious to one of ordinary skill in the art to have further modified the combination of Rofrano and Sammon, Jr. et al. to have inserted additional product configuration parameters in the product matrix to replace the selected product configuration parameter in order to continuously and dynamically update and fine tune the matrix owing to the "Question and Answer Tree" taught by Rofrano.

Regarding claims 30-45

The combination of Rofrano and Sammon, Jr. et al. does not teach that the products are specifically a refrigerator, a washer, a dryer, or an air conditioner.

Rofrano, however, teaches that his invention provides a way for employing the vast knowledge of a skilled sales agent to assist actual shoppers using an electronic catalog (col. 3, lines 8-10). Rofrano uses an example of a camera as a type of product which often requires knowledgeable input from a sales agent.

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Despite being silent to other specific products, it is clear that products such as refrigerators, washers, dryers, and/or air conditioners could have been employed in the Rofrano invention. This is because such products are known to be offered in various configurations across brand lines and across model lines, for example. The input of a skilled sales agent is invaluable when trying to arrive at a selection of one of these products in the same manner as arriving at a selection of a camera (as already taught by Rofrano).

Accordingly, it would have been obvious to one of ordinary skill in the art to have further provided the combination of Rofrano and Janssen to have allowed for the consideration of refrigerators, washers, dryers, and/or air conditioners in order to have provided the benefit of the knowledge of a sales agent in the complex consideration of such products.

Regarding claims 4, 6, 9, 17, 19-24, 29, and 38-41

Rofrano does not explicitly disclose a "web" environment, and accordingly Rofrano does not explicitly teach user interfaces typical of a "web" environment. Such interfaces include toggle buttons, other buttons (i.e. "Compare" buttons), hyperlinks, etc....

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However, it is noted that Rofrano recognizes that similar product selection methods, tools, and program products are employed in a "web-type" environment. Rofrano acknowledges catalogs being offered through dial-up computer services such as PRODIGY (TM) (col. 1, lines 29-37).

Sammon, Jr. et al., however, employing a "web" environment by providing a web page comprising a plurality of user input interfaces (see Figs. 4-13 and their respective descriptions). Sammon, Jr. et al. teaches that such input interfaces may comprise check boxes (col. 12, lines 52-56), toggles (col. 13, lines 7-10), buttons (col. 13, lines 30-33), and, of course, support of hyperlinks (col. 5, lines 56-56-62).

It would have been obvious to one of ordinary skill in the art to have provided the invention of Rofrano to have been provided in a "web" environment and to have made use of known input interfaces such as web pages incorporating buttons, toggles, hyperlinks, etc... (such as taught by Sammon, Jr.) in order to have taken advantage of the World Wide Web as an extensive communications network.

Regarding claims 4, 24, and 29

Rofrano teaches the presentation of products for the purposes of providing a "side-by-side" comparison (col. 4, lines

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38-41). Rofrano, however, does not teach the activation of toggle buttons and a "Compare" button to arrive at such "side-by-side" comparison.

However, and as noted above, Sammon, Jr. teaches the use of toggles and buttons in order to allow the user to input instructions to their "web-based" invention.

It would have been obvious to one of ordinary skill in the art to have provided the invention of Rofrano to have included the "web-based" functionality of Sammon, Jr. in order to have allowed the user to have designated products for a side-by-side comparison at any time and to have arrived at the "side-by-side" comparison display such as that already taught by Rofrano.

Regarding claim 6

Rofrano does not teach formatting model identifiers as hyperlinks.

However, and as noted above, Sammon, Jr. teaches the use of HTML which supports hyperlinking.

It would have been obvious to one of ordinary skill in the art to have hyperlinked any identifier in order to have provided an easily accessible source for information particular to the identifier. Such functionality of hyperlinking is well-known in the art and would have served to have provided cross-referencing

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between a page and other arrangements of related information--
i.e. one or more other pages.

Regarding claims 7 and 20

The combination of Rofrano and Sammon, Jr. does not teach the specific column headings recited here.

However, the differences between the Rofrano headings (see Table 1) and those of the instant invention lie solely in the nature of the descriptive material. In the instant case, the descriptive material is non-functional since it does not affect or effect the underlying display of data. Accordingly, such specific headings cannot serve to patentably distinguish the instant invention from any other obvious variation of the Rofrano headings--any such variations being obvious variations of the headings already taught by Rofrano.

Regarding claims 8 and 21

Rofrano, thus modified to include the obvious headings of claim 7, still does not provide an "input and sort" functionality.

However, and as discussed above, Sammon, Jr. teaches a "web" environment employing HTML.

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It would have been obvious to one of ordinary skill in the art to have provided such well-known web functionality as an "input and sort" for the various displayed columns in order that the user may organize the displayed data in a desired order (e.g. in ascending order by "Price").

Regarding claims 9, 17, and 22

Rofrano does not disclose formatting product parameters as a hyperlink.

However, the Examiner's position on this limitation is the same as that identified above with respect to claim 6.

Claims 10 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rofrano (U.S. Patent No. 6,035,283) and Sammon, Jr. et al. (U.S. Patent No. 6,012,051) as applied to claims 1 and 19 above, and further in view of Janssen (U.S. Patent No. 5,754,850).

Regarding claims 10 and 23

Although the combination of Rofrano and Sammon, Jr. et al. teaches displacing the selected product configuration parameter to a visible location outside the product matrix, the

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combination of Rofrano and Sammon, Jr. et al. does not teach displaying outside the product matrix the product configuration answer, per se. The Examiner notes that such feature is described in the instant specification at the paragraph bridging pages 9 and 10 and is shown in Figure 4 (e.g. "404").

Now comes Janssen.

Janssen, in a similar method, tool, and program product for product selection assistance (col. col. 1, lines 12-16; and col. 4, line 32-col. 5, line 3). Janssen teaches that a product configuration question is presented to a user who responds with an answer to such question. Janssen further teaches that the user is provided with a screen which progressively displays a cumulative listing of the answers (i.e. configuration parameters) provided by the user. Applicant's attention is directed to Figures 3 and 4 and col. 4, lines 39-41. For example, Figure 4 has an additional entry (as compared to Figure 3) of "\$350,000". The additional entry indicates that the user selected \$350,000 as the maximum price in display screen 300 of Figure 3 (see col. 4, lines 49-52).

It would have been obvious to one of ordinary skill in the art to have further modified the combination of Rofrano and Sammon, Jr. et al. to have to have included the teaching of Janssen of providing the product configuration answers in a

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manner consistent with the provision of the product configuration parameters already taught by Sammon, Jr. et al. in order that the user may be continuously apprised of all previous configuration answers at any point in their selection process thereby providing a cumulative listing of their navigation through product selection choices to that point and visually presenting the user a ready reference to all chosen configuration values (consistent with the teaching of Sammon, Jr. et al. noted above) and in order to decide whether to move forward in the process or to move backward in the process (depending on whether or not previous selections are providing desired results) (see Janssen: col. 4, lines 39-43).

Response to Arguments

Applicant's arguments filed May 5, 2005 have been fully considered but they are not persuasive.

Applicant's arguments directed to the failure of Rofrano to provide displacing the selected product configuration parameter to a visible location outside the product matrix is not persuasive. Such feature is admitted as not being taught by Rofrano, but rather by Sammon, Jr. et al. (as discussed above).

Applicant's allegation directed to Sammon, Jr. et al. and its purported failure to remedy the shortcomings of Rofrano are

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not persuasive. The body of the rejection above details the Examiner's interpretation of the Sammon, Jr. et al. reference and its teaching of displacing the selected product configuration parameter to a visible location outside the product matrix. Applicant has not specifically pointed out how Sammon, Jr. et al. fails to teach this feature or how motivation is lacking for making the combination presented above.

Applicant's remarks directed to motivation lacking in the various references is not persuasive. The Examiner has either relied upon explicit teachings in the various references or on motivation which flows from the various references as provided in the bodies of the rejections. The Examiner notes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Applicant's remarks directed to "impermissible hindsight" are not persuasive. It must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account

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only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

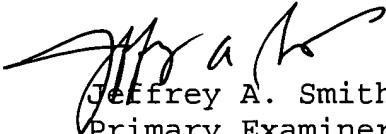
Applicant's arguments directed to the previously applied Double Patenting rejections have been fully considered and are persuasive in view of the amendments to the claims of the 09/681,393 application. Accordingly, these rejections have been withdrawn.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey A. Smith whose telephone number is (571) 272-6763. The examiner can normally be reached on M-F 6:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on (571) 272-7159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jeffrey A. Smith
Primary Examiner
Art Unit 3625

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